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EXAMINER

DARNO, PATRICK A

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/788,532	Applicant(s) HODES, ALAN SCOTT	
	Examiner Patrick A. Darno	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-25 are pending in this office action.

Claim Objections

2. Claim 4 is objected to because of the following informalities:
 - Claim 4 repeats the phrase 'by concept node'. The Examiner believes this is simply a typographical error. Appropriate correction is required.

Double Patenting

1. Claims 1 and 6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 2 of copending Application No. 11/151,781. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference in the wording of the claims is the intended use of the invention. The claims of Application number 11/151,781 seem to be directed to any and all text documents whereas the claims of 10/788, 532 are directed specifically to documents consisting of patent claims. Since patent claims are simply text documents, the claims in the two applications are found to be obvious variations of one another. Appropriate action should be taken to resolve the matter. Appropriate courses of action include amendment of the claims and/or the filing of a terminal disclaimer.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-12 are rejected because the claimed invention is directed to non-statutory subject matter.

With respect to claim 1, the claim is rejected because the claim fails to produce a useful, concrete, and tangible result. The claim language clearly sets forth an abstract idea that simply compares and processes data with no resultant step. The current guidelines followed by the U.S. Patent and Trademark Office maintain that a method claim representing an abstract idea can indeed be patentable when a practical application of the system yields a useful, concrete, and tangible result (State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02).

Specifically the final limitation of "processing the determined correspondence of the portions of the at least one patent claim and the determined correspondence of the portions of the at least one instance" fails to show why this resultant step of processing is in fact useful, concrete, and tangible. In order to overcome this rejection, the claims must be amended in order to clearly set forth a useful, concrete, and tangible result of this processing step.

Claims 1-12 are rejected because they either contain or inherit the deficiencies of claim 1.

4. Claims 3-4 is again rejected under 35 U.S.C. 101 because the claim is directed to non-statutory subject matter.

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Claim 3 is rejected under 35 U.S.C. 101 because the claim clearly recites a computer program that is not embodied on a computer readable medium. A computer program that is not embodied on an acceptable computer readable medium is nothing more than an abstract idea. When the computer program product is recorded on an acceptable computer readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the computer program product to be realized. Appropriate correction is required.

Claim 4 is rejected because it inherits the deficiencies of claim 3.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 11-12, and 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication Number 2002/0111941 issued to Claude Roux et al. (hereinafter "Roux").

Claim 1:

Roux discloses a method of analysis regarding at least one patent claim, comprising:

a) determining a correspondence of the portions of the at least one patent claim to concept nodes of an ontology (Roux: paragraph [0038], lines 7-10 and paragraph

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[0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a patent claim is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a patent claim. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.);

b) determining a correspondence of the portions of at least one instance to the concept nodes of the ontology (Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; Again note that a one 'instance' or embodiment is simply text. The process for steps b) and a) are identical, so the same rejection applies.); and

c) processing the determined correspondence of the portions of the at least one patent claim and the determined correspondence of the portions of the at least one instance (Roux: paragraph [0041] and paragraph [0042], lines 1-3 and paragraph [0043], lines 1-7).

Claim 11:

Roux discloses all the elements of claim 1, as noted above, and Roux further discloses wherein:

step c) includes comparing the determined correspondence of the portions of the at least one patent claim to the determined correspondence of the portions of at least one instance (Roux: paragraph [0041] and paragraph [0043], lines 1-7).

Claim 12:

Roux discloses all the elements of claim 11, as noted above, and Roux further discloses wherein:

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step c) includes processing the ontology to determine a relation between the scope of the concepts to which portions of the at least one patent claim correspond and the scope of the concepts to which respective portions of the at least one instance correspond (Roux: paragraph [0041] and paragraph [0042], lines 1-3 and paragraph [0043], lines 1-7).

Claim 18:

Roux discloses all the elements of claim 1, as noted above, and Roux further discloses wherein:

the step of determining a correspondence of the portions of the at least one patent claim to the concept nodes of an ontology includes , for each of at least one of the portions, adding to the ontology a concept node to which that portion corresponds (Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).).

Claim 19:

Roux discloses all the elements of claim 1, as noted above, wherein:

the step of determining a correspondence of the portions of at least one instance to the concept nodes of the ontology includes, for each of the at least one of the portions, adding to the ontology a concept node to which that portion corresponds (Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).).

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Claim 20:

The method of claim 1, wherein:

the step of determining a correspondence of the portions of the at least one patent claim to the concept nodes of an ontology includes, for each of the at least one of the portions (Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a patent claim is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a patent claim. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.), adding to the ontology a concept node which that portions corresponds (Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).); and

the step of determining a correspondence of the portions of at least one instance to the concept nodes of the ontology includes, for each of the at least one of the portions, adding to the ontology a concept node to which that portion corresponds (Roux: paragraph [0040], lines 11-15 and paragraph [0060] and paragraph [0052]; These references clearly show the adding of a concept node to an ontology (semantic lattice).).

Claim 21:

Roux discloses a system usable for patent analysis, comprising:

an instance record database embodied in a tangible medium, the instance record database comprising a plurality of instance records (Roux: paragraph [0019], lines 5-11 and paragraph [0042], lines 8-11; The internal representation of a document is an

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'instance record'. The document could represent ideas relative to a particular company. The 'instance record' could be generated for numerous types of text documents.),

wherein

each instance record is associated with a separate one of a plurality of instances (Roux: paragraph [0019], lines 5-11),

and

each instance record includes a plurality of portions entries, each portion entry configured to hold an indication of a concept node in an ontology (Roux: Fig. 1, 103 and paragraph [0039] and paragraph [0052]; Note specifically that the semantic lattice is built using ontologies to link together concept nodes.).

Claim 22:

Roux discloses all the elements of claim 21, as noted above, and Roux further discloses a system comprising:

ontology storage holding the ontology (Roux: Fig. 1, 103 and paragraph [0039] and paragraph [0052]; The semantic lattice is composed of ontologies.).

Claim 23:

Roux discloses all the elements of claim 21, as noted above, and Roux further discloses a system comprising:

document storage, holding at least one document, wherein the at least one document embodies the plurality of instances (Roux: paragraph [0002]);

wherein each instance record includes at least one link record configured to hold a link to the separate one of the plurality of instances embodied in the at

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least one document (Roux: paragraph [0051] and paragraph [0052]; Note specifically that each concept is **connected** (linked to) other concepts through relation nodes.).

Claim 24:

Roux discloses all the elements of claim 23, as noted above, and Roux further discloses wherein:

the at least one link included which each instance record is configured to hold includes a plurality of links, wherein each link is a link to a separate portion of the instance with which the instance record is associated (Roux: paragraph [0051] and paragraph [0052]; Note specifically that each concept is **connected** (linked to) other concepts through relation nodes. If there are a plurality of relations, there would be a plurality of links or connections.).

Claim 25:

Roux discloses all the elements of claim 23, as noted above, and Roux further discloses a system comprising:

an instance record index comparing a plurality of entries (Roux: paragraph [0038]; The use of indexes for records in a database is well known in the art.),

wherein, each entry of the instance record index
corresponds to a separate concept node in the ontology, and is configured to hold an indication of the instance records holding an indication of the concept node to which that entry of the instance record corresponds (Roux: paragraph [0038], lines 7-10).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-5 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roux in further view of U.S. Patent Application Publication Number 2004/0181427 issued to Gregory A. Stobbs et al. (hereinafter "Stobbs").

Claim 2:

Roux discloses all the elements of claim 1, as noted above, but Roux does not explicitly disclose wherein:

step a) includes completing a claim record for each of the at least one patent claim under study;

step b) includes completing an instance record for each of the at least one instance under study; and

step c) includes processing the completed claim records and the completed instance records.

However, Stobbs discloses wherein:

step a) includes completing a claim record for each of the at least one patent claim under study (Stobbs: paragraph [0049], lines 5-8; The claims Table clearly contains claim records. These records must have been completed when they were stored in the table.);

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step b) includes completing an instance record for each of the at least one instance under study (Stobbs: paragraph [0049], lines 5-8; The claims Table also represents an instance record. While the two types of records have different names, paragraph [0083] of the Applicant's Specification clearly shows that claim records and instance records can be interchangeable.); and

step c) includes processing the completed claim records and the completed instance records (Stobbs: paragraph [0048], lines 6-9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Roux with the teachings of Stobbs noted above. The skilled artisan would have been motivated to improve the teachings of Roux per the above such that claim information could be stored and presented in a grouped, organized fashion allowing for the convenient and efficient analysis of patent claim information (Stobbs: paragraph [0006], line 13 – paragraph [0007], line 6).

Claim 3:

The combination of Roux and Stobbs discloses all the elements of claim 2, as noted above, and Stobbs further discloses wherein:

the claim record and the instance record are embodied in a computer-readable medium (Stobbs: paragraph [0041], lines 1-10; This reference clearly shows that the program/programs which provide the functionality of the Stobbs invention is/are embodied on a computer readable medium. Since the claim or instance record (claim Table) can be accessed by the program of the Stobbs invention, the claim Table (claim record or instance record) must also be embodied on a computer readable medium.); and

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step c) includes a computer executing a program to process the claim record and the instance record (Stobbs paragraph [0041], lines 1-10).

Claim 4:

The combination of Roux and Stobbs discloses all the element of claim 3, as noted above, and Roux further discloses wherein:

step c) further includes the computer executing a program to process an index to instance records, by concept node, based on at least one concept node indicated in at least one of the completed claim records (Roux: paragraph [0063], lines 1-7; The Roux reference clearly discloses creating an index for records based on concept nodes. The invention set forth in claim 4 is clearly an obvious variation of the what Roux discloses in paragraph [0063].).

Claim 5:

The combination of Roux and Stobbs disclose all the elements of claim 2, as noted above, and Roux further disclose wherein:

completing the claim record and completing the instance record includes indicating the concept node to which each portion of the corresponding claim and instance, respectively, corresponds (Roux: paragraph [0039] and paragraph [0052]; The generation of a semantic lattice (ontology connecting concept nodes) must involve some form of indication of corresponding conceptual nodes.),

processing the completed claim records and the completed instance records includes determining a comparison of the concept nodes indicated by claim records to concept nodes indicated by instance records (Roux: paragraph [0043], lines 1-7).

Claim 13:

Roux discloses all the elements of claim 1, as noted above, but Roux does not explicitly disclose wherein:

a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance infringes the at least one patent claim.

However, Stobbs discloses wherein:

a result of processing the determined correspondence of the portions of the at least one patent claim portions and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance infringes the at least one patent claim (Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9; Note specifically the 'claim validity analysis module' 190 and also 'product coverage / infringement analysis' 188.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Roux with the teachings of Stobbs noted above. The skilled artisan would have been motivated to improve the teachings of Roux with the teachings of Stobbs per the above such that it is possible to discover documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim (Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

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Claim 14:

Roux discloses all the elements of claim 1, as noted above, but Roux does not explicitly disclose wherein:

the at least one instance is prior art to the at least one patent claim (Stobbs: paragraph [0099] and paragraph [0114]); and

a result of processing the determined correspondence of the portions of the at least one patent claim and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance renders the at least one patent claim invalid, if the at least one patent claim is in an issued patent, or unpatentable, if the at least one patent claim is not in an issued patent.

However, Stobbs discloses wherein:

the at least one instance is prior art to the at least one patent claim (Stobbs: Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9; At the very least note where the abstract states 'determine what products might be covered by the claims of the patents or whether materials on the Internet might render patent claims invalid'. If a product is found on the Internet that invalidates a patent, and that product satisfies the criteria set forth in 35 U.S.C. 102 or 35 U.S.C. 103, then the product is prior art.);

a result of processing the determined correspondence of the portions of the at least one patent claim and the determined correspondence of the portions of the at least one instance includes a determination of whether the at least one instance renders the at least one patent claim invalid, if the at least one patent

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claim is in an issued patent, or unpatentable, if the at least one patent claim is not in an issued patent (Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9; Note specifically the 'claim validity analysis module' 190 and also 'product coverage / infringement analysis' 188.).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Roux with the teachings of Stobbs noted above. The skilled artisan would have been motivated to improve the teachings of Roux with the teachings of Stobbs per the above such that it is possible to discover documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim (Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

7. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roux in view of Stobbs and further in view of U.S. Patent Number 6,711,585 issued to Max Copperman et al. (hereinafter "Copperman").

Claim 6:

The combination of Roux and Stobbs discloses all the elements of claim 5, as noted above, but the previously mentioned combination does not explicitly disclose wherein:

determining a comparison includes determining whether there is one to one correspondence between concept nodes in claim records and concept nodes in instance records.

However, Copperman discloses wherein determining a comparison includes determining whether there is a one to one correspondence between

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concept nodes in claim records and concept nodes in instance records

(Copperman: column 15, lines 8-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Copperman noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the use of concept nodes in a document retrieval system provides for faster and more relevant responses than a content-based retrieval system (Copperman: column 2, lines 53-59).

Claim 7:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6, as noted above, and Roux further discloses wherein:

the comparison means is among the concept nodes indicated by each of a plurality of ones of the instance records, respectively, and the concept nodes indicated by one claim record (Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

Claim 8:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 7, as noted above, and Roux further discloses wherein:

the comparison includes considering the scope of the concepts corresponding to the concept nodes indicated by each instance record, respectively, relative to the scope of the concepts corresponding to the concept

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nodes indicated by the one claim record (Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

Claim 9:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6, as noted above, and Roux further discloses wherein:

the comparison is among the concept nodes indicated by each of a plurality of ones of the claim records, respectively, and the concept nodes indicated by one instance record (Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

Claim 10:

The combination of Roux, Stobbs, and Copperman discloses all the elements of claim 6, as noted above, and Roux further discloses wherein:

the comparison is among the concept nodes indicated by each of a plurality of ones of the claim records, respectively, and the concept nodes indicated by one instance record (Roux: paragraph [0041] and paragraph [0043], lines 1-7 and paragraph [0052]).

8. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roux in view of Stobbs and further in view of Non-Patent Literature Article titled "Generating Patent Claims From Interactive Input" issued to Svetlana Sheremetyeva et al. (hereinafter "Sheremetyeva").

Claim 15:

The combination of Roux and Stobbs discloses all the element of claim 14, as noted above, and Roux further discloses a method comprising:

determining a correspondence of the portions of an embodiment to the concept nodes of the ontology (Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a description of an embodiment of a invention is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a description of an embodiment of an invention. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology.).

The previously mentioned combination does not explicitly disclose processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon.

However, Shremetyeva discloses processing the determined correspondence of the embodiment portions and formulating the at least one patent claim based at least in part thereon (Shremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Shremetyeva noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the system and method aid an inventor in composing patent claims (page 2, left column, lines 34-37).

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Claim 16:

The combination of Roux, Stobbs, and Shremetyeva discloses all the elements of claim 15, as noted above, and Shremetyeva further discloses:

the formulated at least one patent claim is a first formulated at least one patent claim (Shremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14; The reference clearly shows formulating a patent claim. Surely one of the formulated claims has to be a first claim.); and the method further comprises

formulating a second at least one patent claim (Shremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14; If one can generate a first patent claim, one can generate a second patent claim.).

Neither Roux nor Shremetyeva explicitly discloses wherein the analysis of the patent claim consists at least in part on the determination of whether the at least one prior art instance renders the first at least one patent claim unpatentable.

However, Stobbs discloses wherein the patent claim analysis consists at least in part on the determination of whether the at least one prior art instance renders the first at least one patent claim unpatentable (Stobbs: Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the

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further teachings of Stobbs noted above. The skilled artisan would have been motivated to improve previously mentioned combination with the further teachings of Stobbs per the above such that it is possible to discover and consider documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim (Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

Claim 17:

The combination of Roux and Stobbs discloses all the elements of claim 14, as noted above, and Roux further discloses:

determining a correspondence of the portions of an embodiment to the concepts nodes of the ontology (Roux: paragraph [0038], lines 7-10 and paragraph [0039] and paragraph [0040], lines 8-11 and paragraph [0041] and paragraph [0052], lines 1-4 and paragraph [0075]; It is important to note that a description of an embodiment of a invention is simply text. So performing a scan and search on a text document is the same as performing a scan and search on a description of an embodiment of an invention. Further note that the 'semantic lattice' is a conceptual graph of relationships between words that is built using a thesaurus or ontology).

Roux does not explicitly disclose wherein the correspondence of at least one prior art instance is considered in the analysis of a patent claim. However, Stobbs discloses wherein the correspondence of at least one prior art instance is considered in the analysis of a patent claim (Stobbs: Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Roux with the teachings of Stobbs noted above. The skilled artisan would have been motivated to improve the teachings of Roux with the teachings of Stobbs per the above such that it is possible to discover and consider documents, products, or product descriptions that validate, invalidate, or infringe upon a patent claim (Stobbs: paragraph [0107], lines 1-12 and paragraph [0108], lines 1-8 and paragraph [0109], lines 1-10 and Abstract and Fig. 9).

Neither Roux nor Stobbs discloses processing the determined correspondence of the embodiment portions and formulating at least one patent claim based at least thereon. However, Shremetyeva discloses processing the determined correspondence of the embodiment portions and formulating at least one patent claim based at least thereon (Shremetyeva: Abstract, lines 4-5 and page 2, left column, lines 34-37 and page 2, right column, lines 7-10, 14-17, 23-29 and page 3, Fig. 2, 10-14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the previously mentioned combination with the teachings of Shremetyeva noted above. The skilled artisan would have been motivated to improve the previously mentioned combination per the above such that the system and method aid an inventor in composing patent claims (page 2, left column, lines 34-37).

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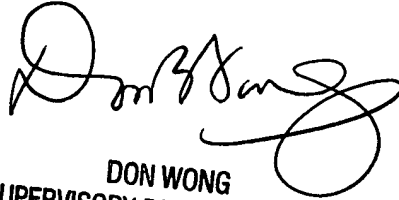
Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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